

Interview Summary	Application No. 10/694,021	Applicant(s) ROSENTHAL, HENRY	
	Examiner Vinh T Luong	Art Unit 3682	

All participants (applicant, applicant's representative, PTO personnel):

(1) Vinh T Luong. (3)_____.

(2) John W. Fitzpatrick. (4)_____.

Date of Interview: 30 September 2004.

Type: a) ☐ Telephonic b) ☐ Video Conference
c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☒ Yes e) ☐ No.

If Yes, brief description: one sample of the grip of the invention and one sample of the grip of the prior art are shown.

Claim(s) discussed: 1-10 as seen in the proposed amendment under 37 CFR 1.111 attached.

Identification of prior art discussed: Larson'315, Oury, admitted prior art, Jannard et al., and Downey.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Vinh T. Luong
Primary Examiner



Examiner's signature, if required

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant contended that the proposed drawing correction by adding referential numerals 11, 13, and 28 would not introduce new matter. The Examiner respectfully disagreed because, e.g., the original disclosure does not provide support for the new feature that the inner layer 11 is located at the outer surface and at the end wall 12. Applicant further contended that: (a) Larson'315's grip is for bicycle handlebar, not motorcycle handlebar; and (b) Larson does not teach the projections progressively decreased in the base area. The Examiner respectfully pointed out that: (a) Larson'315's grip is inherently adapted to fit onto motorcycle handlebar; and (b) the original drawings do not show the location of the base area, therefore, the Examiner would consider Applicant's arguments regarding Larson'315 in view of the original disclosure and amendment. Applicant also contended that Applicant's projections which are decreased progressively would not be a matter of choice in design since they would improve the wear and tear over the grip of prior art, such as, the one of Oury.



Vinh T. Luong
Primary Examiner

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Henry ROSENTHAL

Application No.: 10/694,021

Filed: October 28, 2003

For: TAPERED GRIP FOR MOTORCYCLE HANDLEBAR

PROPOSED

Group Art Unit: 116364

Examiner: V. Luong

Docket No.: 116364

AMENDMENT UNDER 37 C.F.R. §1.111

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the July 7, 2004 Office Action, and the personal interview conducted on September 30, 2004, please consider the following:

Amendments to the Specification;

Amendments to the Claims as reflected in the listing of claims;

Amendments to the Drawings include an attached replacement sheet; and

Remarks.

Amendments to the Specification

Please replace the paragraph beginning on page 4, line 7, with the following rewritten paragraph:

The hand grip is formed from two different grades of rubber. A firmer less flexible grade is used to form a base or inner ~~layer~~ layer 11 of the body 10, as well as the end wall 12 and the flange 14. A softer, more flexible grade is used to form an outer ~~layer~~ layer 13 to the body 10, including a raised pattern of adjoining rectangles 16 on one side of the body 10 and a pattern of surface projections 18 which are also present inside the boundary of the aforesaid rectangular pattern 16.

Please replace the paragraph beginning on page 4, line 14, with the following rewritten paragraph:

The projections 18 in this embodiment are generally in the form of a plurality of adjacent square pyramids, each having a diamond shaped ~~base~~ base 28, i.e. its diagonal being axial relative to the cylindrical body 10 of the grip. The overall size of the respective pyramidal projections 18 decreases gradually from adjacent the flange 14 to adjacent the closed end. Thus the diamond shaped ~~bases~~ bases 28 decrease in area and the height of the projections also decreases. This provides an overall taper to the external diameter of the body 10.

Please replace the Abstract with the attached amended Abstract.

Amendments to the Claims:

The following listing of claims will replace all prior versions, and listings, of claims in the application:

1. (Currently Amended) A hand grip adapted for non-rotatable fitting onto a motorcycle handlebar end section, ~~and the hand grip~~ comprising:
_____ a hollow cylindrical body having a first, open ~~end~~, end;
_____ an opposing, second ~~end~~, end; and
_____ an annular flange projecting radially outwards at the first, open end, the cylindrical body also having an external surface formed with a plurality of projections distributed thereover, said projections progressively decreasing in base area and in height from adjacent the flange to adjacent the second end so as to provide an external taper to the body.
2. (Original) A hand grip as set forth in claim 1 wherein the external diameter of the cylindrical body reduces by less than 5mm from adjacent the flange to adjacent the second end.
3. (Original) A hand grip as set forth in claim 1 wherein the second end is closed by an end wall.
4. (Original) A hand grip as set forth in claim 3 wherein the cylindrical body is formed from an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer.
5. (Original) A hand grip as set forth in claim 4 wherein the annular flange and the closed end wall are formed of the same formulation of material as the inner layer of the cylindrical body.
6. (Original) A hand grip as set forth in claim 4 wherein the inner layer is of substantially constant external diameter, while the outer layer tapers in its external diameter.

7. (Original) A hand grip as set forth in claim 1 wherein the cylindrical body is formed from an inner layer and an outer layer of different formulations of flexible, resilient material, in which respect the outer layer is of greater flexibility than the inner layer.

8. (Currently Amended) A hand grip as set forth in claim 7 wherein the annular flange ~~and~~ is formed of the same formulation of material as the inner layer of the cylindrical body.

9. (Original) A hand grip as set forth in claim 7 wherein the inner layer is of substantially constant external diameter, while the outer layer tapers in its external diameter.

10. (Canceled)

Amendments to the Drawings:

The attached replacement drawing sheet makes changes to Fig. 1 and replaces the original sheet with Figs. 1 and 2.

Attachment: Replacement Sheet

REMARKS

Claims 1-9 are pending in this application. Claim 10 is canceled without prejudice to or disclaimer of the subject matter recited therein. By this Amendment, the specification, claims and drawings are amended. No new matter is added.

I. Election/Restriction

Applicant confirms the election of species I, Fig. 3, claims 1-10 and acknowledges that claim 1 is generic as indicated in the outstanding Office Action.

II. Drawings

The drawings are objected to under 37 C.F.R. §1.83(a). Applicant submits that Fig. 1 is amended in reply to the objection, and therefore request that the objection to the drawings be withdrawn.

III. Specification

The disclosure is objected to for failing to designate each claimed feature with a reference numeral character in the specification. As the specification is amended in reply to the objection, Applicant requests the objection to the disclosure be withdrawn.

IV. Claim Rejections Under 35 U.S.C. §112

Claims 4-9 are rejected under 35 U.S.C. §112, first paragraph. Specifically, the Office Action points out that claims 4-9 "call for the inner and outer layers of different formulations of a flexible, resilient material." The Office Action alleges that the drawings do not show the inner and outer layers. However, as indicated above, the drawings are amended in reply to the objection to designate the inner and outer layers with reference numbers.

The Office Action also states that "it is unclear as to how Applicant makes/uses the inner and outer layers and attaches them together to form the claimed hand grip." However, as such a method is not recited in the pending claims, there is no basis for which to object to

height from adjacent the flange to adjacent the second end so as to provide an external taper to the body.

Although the Office Action rejects claims 1-3 and 10 over Oury, the Office Action admits that Oury discloses projections progressively increasing in height from adjacent the flange to adjacent the second area. The Office Action then alleges that it is common knowledge in the art at the time the invention was made to decrease, instead of to increase, the height of Oury's projections in order to maximize the amount of torque which may be transmitted from the rider to the grip.

Applicant submits that "it is never appropriate to rely totally on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." See MPEP §2144.03 citing In re Zurko, 258 F.3d at 1385, 59 USPQ 2d at 1697. As the Office Action fails to provide evidentiary support for such common knowledge, Applicant submits that such a rejection is improper.

The Office Action further contends that although Oury's projections progressively increase instead of decrease in height from adjacent the flange to adjacent the second end, that the reversal/rearrangement of the height of Oury's projections would have been a matter of choice of design since the claims structures and the function they perform are the same as the prior art.

Applicant submits that as Oury merely discloses ornamentation on the cycle handle grip, that no function of such ornamentation can, or may be, claimed. Rather, by definition, a design application cannot claim a function, but rather is merely for ornamentation.

Furthermore, the decrease in height of the projections from adjacent the flange to adjacent the second end is not merely a design choice as such a decrease in height provides the external taper to the body as recited in the rejected claims. Thus, increasing the height of the projections, as in Oury actually "teaches away" from the claimed subject matter.

Furthermore, as clearly provided in the specification "by making the region adjacent the flange 14 somewhat thicker, particularly making this extra thickness from the soft rubber compound, extra cushioning on the rider's hand is provided in exactly the region of greatest pressure and greatest wear, i.e., below the arch formed by thumb and forefinger. Also because there is more material, this region does not wear down, split and fail as quickly as hitherto in the case of substantially constant external diameter grips." Thus, the arrangement of the projections as recited in the claims is not merely design choice, but provides the structure necessary to overcome the deficiencies of known motorcycle grips.

Regarding claim 2, the Office Action alleges that Oury teaches the invention substantially as claimed and admits that Oury does not teach an external diameter of the cylindrical body being reduced by less than 5mm from adjacent the flange to adjacent the second end. However, the Office Action again alleges that it is "common knowledge" to form the external diameter as recited in claim 2. However, as stated above, it is never appropriate to rely solely on common knowledge in the art without evidentiary support on the record. Furthermore, to imbue one of ordinary skill in the art with knowledge of the invention when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome where in that which only the inventor taught is used against its teacher. W. L. Gore and Associates v. Garlock, Inc. 721 F.2 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Accordingly, Applicant respectfully requests the rejection of claims 1-3 and 10 under 35 U.S.C. §103(a) be withdrawn.

Claims 4-7 are rejected under 35 U.S.C. §103(a) as unpatentable over Oury in view of Applicant's admitted prior art. The rejection is respectfully traversed.

Applicant asserts that claims 4 and 7 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Additionally, as Applicant's admitted prior art does not overcome the

deficiencies of Oury discussed above, Applicant requests the rejection of claims 4 and 7 under 35 U.S.C. §103(a) be withdrawn.

Claims 4, 5, 7 and 8 are rejected under 35 U.S.C. §103(a) as unpatentable over Oury in view of U.S. Patent 4,416,166 to Jannard et al. (Jannard). The rejection is respectfully traversed.

Applicant asserts that dependent claims 4, 5, 7 and 8 are allowable for at least their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Additionally, as Jannard does not overcome the deficiencies of Oury, Applicant respectfully requests the rejection of claims 4, 5, 7 and 8 under 35 U.S.C. §103(a) be withdrawn.

Claims 6 and 9 are rejected under 35 U.S.C. §103(a) as unpatentable over Oury in view of Jannard, and further in view of U.S. Patent 5,261,665. The rejection is respectfully traversed.

Applicant asserts that claims 6 and 9 are allowable for their dependency on independent claim 1 for the reason discussed above, as well as for the additional features recited therein. For example, Applicant asserts that the combination of references fails to disclose or suggest a hand grip ... wherein the inner layer is of substantially constant external diameter and the outer layer tapers in its external diameter.

The Office Action alleges that Downey teaches an inner layer 12 being of substantially constant external diameter while the outer layer 14 is tapers in its external diameter in order to provide better gripping for a rider's hands. However, as Downey relates to a golf club grip, Applicant submits that Downey does not teach such a structure "in order to provide better gripping for a rider's hand" as alleged in the Office Action.

Additionally, there is no motivation or suggestion in any of the references to combine the teachings of a golf club grip with either the teachings of Oury or Jannard. For example,

each of Oury and Jannard related to cycle hand grips to fit over a handlebar of a cycle. In contrast, Downey relates to golf club grips. Thus, one skilled in the art of cycle grips would not look to the teachings of the golf club art to achieve the structure recited in the rejected claims. Accordingly, Applicant respectfully requests the rejection of claims 6 and 9 under 35 U.S.C. §103(a) be withdrawn.

VII. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-9 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

Thomas J. Pardini
Registration No. 30,411

John W. Fitzpatrick
Registration No. 41,018

TJP:JWF/djb

Attachments:

Amended Abstract
Replacement Sheet

Date: September 30, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>

ABSTRACT OF THE DISCLOSURE

TAPERED GRIP FOR MOTORCYCLE HANDLEBAR

A motorcycle handlebar hand grip ~~comprises~~has a hollow cylindrical body ~~having~~with a first, open end and an opposing, second end, which may be open or closed, and an annular flange projecting radially outwards at the first, open end. In order to prolong its useful life as regards wear by a rider's hand, and also improve comfort and vibration damping, the body has an external surface which is formed with projections and which tapers from adjacent the flange to adjacent the second end. The taper is achieved by the projections progressively decreasing in height from adjacent the flange to adjacent the second end. The base area of the respective projections may also progressively decrease in size from adjacent the flange to adjacent the second end.

1/2

